

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1 and 4-24 are pending in the application, with claims 1, 19, and 20 being the independent claims. Claims 2 and 3 were previously cancelled.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Advisory Action

Applicants acknowledge with appreciation the Examiner's issuance of an Advisory Action mailed on 1/28/2009.

35 U.S.C. §103(a) Rejections

Independent claims 1 and 19, and claims 4, 5, and 13-18 stand rejected under 35 U.S.C. 103 over U.S. 5,102,010 to Osgar (hereinafter "Osgar"). This rejection is respectfully traversed.

The Examiner admitted in the final office action mailed 8/20/2008 that Osgar does not teach a bag having at least one welded seam of a substantially T-shaped or V-shaped configuration. Final Office action at page 5. The Examiner then alleged that since "the criticality of the welded seam shape" was not supported in the specification, and therefore concluded that a T-shaped or V-shaped configuration would be merely an "obvious design choice." Final Office action at page 6.

In applicant's reply dated 12/22/2009, the allegation that the "the criticality of the welded seam shape" was not supported in the specification was traversed. The criticality of welded seam shape is that it defines the deformation of the foil bag as liquid is withdrawn from it. See specification paragraph [0074]. It is known in the art that a foil bag resists collapsing when liquid is withdrawn from it. One implication of this problem is that the amount of usable liquid is decreased, because some residual liquid is effectively trapped inside the bag instead of being delivered for its intended use. The shape of the weld seam is one factor that defines the deformation of the foil bag as liquid is withdrawn from it.

The Examiner admitted in the Advisory Action mailed 1/28/2009 that the criticality of the bag shape is supported in the specification. Despite this admission, the Examiner continued to allege that T-shaped or V-shaped weld seam configurations are matters of "obvious design choice." But an "obvious design choice" type-rejection is precluded where the claimed structure and the function it performs are different from the prior art. See *In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed.Cir. 1992). As to the claimed structure, the Examiner admits that Osgar "does not expressly disclose the bag having at least one welded seam of a substantially T-shaped or substantially V-shaped configuration." See the Final Office action at page 5. As to the function the claimed structure performs, the configuration of the weld seams defines the deformation of the foil bag as liquid is withdrawn from it. See specification paragraph [0074]. Since Osgar does not have the same structure and function as the weld seams in the instant application, the "obvious design choice" rejection is precluded. *In re Gal*.

In the advisory action, the Examiner alleges that bags having *either* T-shaped or V-shaped weld seams "perform substantially the same function, and therefore it would have been obvious to those skilled in the art at the time the invention was made to make the welded seam of a T-shaped or V-shaped configuration." But claims 1 and 19 recite a "welded seam of a substantially T-shaped or substantially V-shaped configuration." It is not proper for the Examiner to use two claim limitations recited in the instant application to conclude that the claim is obvious over itself. This is impermissible hindsight. The Examiner has not produced prior art that either teaches or suggests all of the claim limitations recited in claims 1 and 19; therefore, the rejection should be withdrawn.

Claims 4, 5, and 13-18 depend from claim 1 and should be allowable for at least this reason.

Independent claim 20 stands rejected under 35 U.S.C. 103 over U.S. 6,158,676 to Hughes (hereinafter "Hughes") in view of Osgar. This rejection is respectfully traversed.

The Examiner cites the definition of "propellant" from the American Heritage dictionary and alleges that "any propellant atomizer needs flow (gas or liquid) caused by the external pressure source (pressurized gas, liquid, etc.) for functioning." (emphasis added) Final Office Action dated 8/20/2008 at page 3.

Applicant points out that claim 20 recites, inter alia, "A propellant gas-free atomizer..." (emphasis added) The term "free" is used to modify the term "propellant gas-." In other words, claim 20 is directed at an atomizer that *does not use* propellant gas. Propellant gases are undesirable for several reasons, one of them being

environmental. With this understanding, it is apparent that the atomizer of Hughes cannot be combined with the container of Osgar to provide a "propellant gas-free atomizer" because Hughes teaches "aerosol metered dose vial 412 feeds a pressurized gas combined with and containing medicant ... pressurized gas and medicament then exits..." (emphasis added) Hughes col. 12, lines 38-41. Hughes teaches away from what is being claimed because the medicament is mixed with pressurized gas from an external source before being delivered to the patient. The patient will therefore receive gas and medicament. For at least this reason, the rejection should be withdrawn. *See* MPEP §2145 X D(2) (stating "it is improper to combine references where the references teach away from their combination.")

The Examiner acknowledged the above arguments with respect to claim 20 in the Advisory Action mailed 1/28/2009, but has not addressed the issue that Hughes does not teach or suggest a "a propellant gas-free atomizer..." The Examiner alleged that "since Hughes and Osgar belong to the similar problem solving area i.e. atomizing the medicinal content, the combination is proper." Even if Hughes and Osgar were in a similar problem solving area, it is still improper to combine them since Hughes teaches away, as described above.

Claims 21-24 depend from claim 20 and should be allowable for at least this reason.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



David K. S. Cornwell
Attorney for Applicants
Registration No. 31,944

Date: 2-20-09

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

SKGF_943736.1